REMARKS

Claims 1-22 are pending in the application.

Claims 1-22 have been rejected.

Claims 5 and 6 have been objected to.

I. DECLARATION

Applicant thanks Examiner for indicating that the declaration is defective. Enclosed herewith is a supplemental executed declaration.

II. CLAIM OBJECTIONS

The Office Action objected to claims 5 and 6 because the claims initially recited the abbreviations GPSK and RF. Applicants have corrected claims 5 and 6 as appropriate.

III. AMENDMENTS TO THE SPECIFICATION

Minor clarifying and correcting amendments have been made to the specification. No new matter is added.

IV. CLAIM REJECTIONS – 35 USC § 103

The Office Action rejected claims 1-12, 16-19 and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0183013 by Auckland et al. (Auckland) in view of U.S. Patent No. 4,652,872 issued to Loyer (Loyer). Additionally, the Office Action rejected dependent claims 13-15 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over Auckland in view of Loyer and further in view of U.S. Patent No. 5,136,582 issued to Firoozmand (Firoozmand).

A *prima facie* obviousness rejection requires that three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the

references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2142; *In re Vaeck*, 947 F. 2d. 488 (Fed. Cir. 1991).

Applicant respectfully submits that independent claims 1, 7, and 17 are not rendered obvious over Auckland in view of Loyer. Applicant respectfully submits: (1) that all of the claim limitations are not taught by the cited references, (2) that the combination of the cited references teaches away from the claimed invention, and (3) even if the claim limitations were taught, that the Office Action uses impermissible hindsight to piece together these references when there is no teaching, suggestion, or motivation to do so.

Auckland generally teaches a radio communication device that may be used to tune an antenna to operate over a range of frequencies. On the other hand, Loyer generally discloses: "a serial communications interface for coupling a physical layer such as a modem to a media access control layer in a token bus network." (Abstract).

The Office Action concedes, on page 4, that "Auckland does not describe the memory structure for storing addresses for accessing data blocks." The Office Action also concedes by inference that Loyer does not disclose "baseband processing circuitry *including* a first in, first out memory structure for storing addresses for accessing data blocks," as recited in claim 1.

In fact, Loyer merely makes limited reference to using a FIFO memory, teaching that a "FIFO 18 is provided for message buffering." (Col. 5, Lines 47-48). However, using a FIFO for "message buffering" is not the same as using a first in, first out memory structure for storing addresses for accessing data blocks. Accordingly, Loyer's mere mention that a FIFO is provided for message buffering is insufficient to teach or suggest all of the recited claim limitations of Applicant's invention.

Moreover, Loyer's description in Fig. 6, showing the interrelationships of the structures used by Token Bus Controller 10 in its buffer management, teaches away from a "*first in, first out* memory structure for storing addresses for accessing data blocks," as recited in claim 1. Loyer teaches that the "receive queue pointers are both the "head" and the "tail" of the queue because the queue is a null set at initialization." (Col. 9, lines 50-52). There is no order to the queue in Loyer, let alone a *first in, first out* order. Accordingly, the hypothetical combination would teach away from the claimed invention.

For the sake of argument, even if Loyer taught the "first in, first out memory structure for storing addresses for accessing data blocks", Applicant respectfully submits that independent claims 1, 7, and 17 are not rendered obvious by Auckland in view of Loyer because there is no teaching, suggestion, or motivation to make the combination proposed by the Office Action. As aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316 (Fed. Cir. 2000):

> Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In this instance, the only motivation cited by the Office Action for combining the features of Auckland and Loyer is that - "it would have been obvious to one of ordinary skill in the art at the time of invention to include memory structures as suggested by Loyer in Auckland's system to dynamically allocate buffers to appropriate queue." This purported motivation to combine Auckland and Loyer is insufficient, as a matter of law, because it does not rely on the teachings of the references. Rather, the alleged motivation for making the combination stems from the **result** of the combination. Since the **result** of the combination did not exist in the art at the time of Applicant's invention, the result cannot, as a matter of law, form the motivation for the combination in the first instance.

There is quite simply no teaching, suggestion, or motivation to render obvious Applicant's novel and non-obvious invention for storing and transmitting data by storing a data block in random access memory, and storing a pointer that corresponds to the data block in a first in, first out memory structure -- besides Applicant's own invention -- which is impermissible hindsight.

Accordingly, Applicant respectfully submits that the Final Office Action has failed to set forth a prima facie case of obviousness and respectfully requests that the rejection of independent claims 1, 7, and 17 be withdrawn. The dependent claims are allowable for substantially the same reasons.

Applicant believes the case is now in condition for allowance. Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 50-2126 (BP1907).

Respectfully submitted,

Date: June 9, 2005

James A. Harrison
Registration No. 40,401

Garlick, Harrison & Markison, LLP
P.O. Box 160727
Austin, TX 78716-0727
Telephone: (214) 902-8100
Facsimile: (214) 902-8101
jharrison@texaspatents.com

CUSTOMER NUMBER: 51,472